

Remarks/Arguments

The Office requires an election of an invention selected from the following groups:

Group I, claims 1-10, drawn to bispecific antibody compositions with the additional requirement that further election of a cell that is either a cancer cell (group A) or virally-infected cell (group B). If a cancer cell is elected, it is further required that a type of cancer listed in claims 9 and 10 be elected.

Group II, claims 11-16 and 23-29, drawn to methods of killing cancer cells. If this group is elected, further election of a type of cancer listed in claims 12, 14, 24 and 26 is required.

Group III, claims 17-22 and 30-36, drawn to methods of killing virally infected cells.

In response, Applicant elects Group I claims 1-10 drawn to bispecific antibodies and further elects with traverse 'cancer cells' (group A) and further elects with traverse breast carcinoma as listed in claims 9 and 10.

With respect to the traversals, Applicant objects to the splitting of the types of cells into the two subdivisions, namely cancer cells and virally infected cells. It is argued by the Office that the cells of group A are affected by cancer while the cells of group B are infected with a pathogen, therefore, each set of cells has different characteristics and morphology. While this point is not in dispute, it cannot be said that the two groups of cells are distinct in having differing characteristics sufficient to generate differing inventions. In the first case, the group A cells express TRAIL R1 and TRAIL R2. Likewise, in the second case the group B cells also express TRAIL R1 and TRAIL R2. Both populations of cells are then treatable by the bispecific antibodies of the invention. The differences that the Office points to in order to impose a species election are inconsequential to the larger invention since all cells of the invention have common traits, *i.e.*, the appropriate receptors that can be bound by the claimed bispecific antibodies. If these two groups are held separate, it must be clarified how they can be separate inventions given the claim language otherwise the Applicant is at risk of facing a double patenting rejection in a later application. Indeed, MPEP 806.04(h) states that: "Restriction should not be required if the species claimed are considered clearly unpatentable over each other."

In addition, Applicant objects to the requirement that a single type of cancer cell be elected from those listed in claims 9 and 10 for the same reasons provided above. More specifically, each cancer cell type that is included in the scope of the claims is one that has the proper receptors and is bound by the claimed bispecific antibody. Thus, it is respectfully submitted that this twofold species election, namely of cancer cells versus virally infected cells and election of breast carcinoma cells, is not proper and withdrawal is respectfully requested.

Appl. No. 09/839,632
Amdt. dated August 4, 2004
Reply to Office action of March 11, 2004

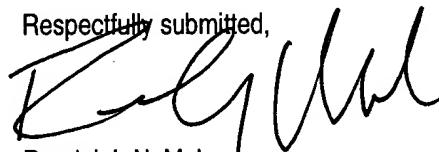
Amendments to the Claims

Claim 1 is amended and this amendment is fully supported in the specification as filed. Claims 11-36 are cancelled as drawn to non-elected inventions and Applicant reserves the right to prosecute these inventions in future related divisional applications. Thus, claims 1-10 are pending upon entry of the present amendment.

Conclusion

Applicant respectfully submits that the presently claimed invention is in form for allowance and requests allowance. The Examiner is encouraged to telephone the undersigned if it will assist in advancing prosecution.

Respectfully submitted,



Randolph N. Mohr
Attorney/Agent for Applicant(s)
Registration No.: 45,590
Phone: (805) 447-8949
Date: August 4, 2004

Please send all future correspondence to:

US Patent Operations/ RNM
Dept. 4300, M/S 27-4-A
Immunex Corporation
One Amgen Center Drive
Thousand Oaks, California 91320-1799